REMARKS

This Amendment responds to the Office Action of January 25, 2005, which states that claims 3-5 and 8 are pending, of which claims 3-5 and 8 stand rejected. By this response, claims 3-5 have been amended, and claim 8 continues unamended.

In view of both the amendments presented above and the following discussion, the applicant submits that none of the claims now pending in the application are obvious under the provision of 35 U.S.C. §103. Thus, the applicant believes that all of these claims are now in allowable form.

It is to be understood that the applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to applicant's subject matter recited in the pending claims. Further, applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

Rejections under 35 USC § 103

Claims 3-5 and 8 were rejected as reciting subject matter that would have been obvious over U.S. Patent 6,453,299 to Wendkos et al (hereinafter "Wendkos") in view of U.S. Patent 6,464,583 to Kidron. The applicant respectively traverses the rejection.

The applicant's invention, as recited in independent claim 3 (and similarly in independent claims 4, 5, and 8) recites:

> A method of selling and purchasing at least one object of purchase from a content provider site over a computer network, said method comprising the following steps:
>
> a. receiving a request at said site to find said at least one object of purchase, each of said at least one object of purchase having attributed to it a probability of obtaining said each of said at least one object of purchase at no cost to said purchaser, wherein said probability of purchase at no cost to said purchaser is communicated to the purchaser prior to selecting said at least one object for purchase;
>
> b. receiving a selection of said at least one object of purchase for purchase;
>
> c. confirming an order for said at least one object of purchase;

d. determining whether payment must be made for said each of said at least one object of purchase; and

e. receiving payment for only those objects of purchase from said at least one object of purchase for which payment was determined to be required in step d,

wherein said step of determining whether payment must be made for said each of said at least one object of purchase comprises the following steps:

(1) generating a random number between a first predetermined value and a second predetermined value for said each of said at least one object of purchase;

(2) offering said each of said at least one object of purchase to said purchaser at no cost if said random number is equal to a third predetermined value; and

(3) requiring payment for said each of said at least one object of purchase if said random number is not equal to said third predetermined value. (emphasis added).

The test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

The applicant's invention relates to on-line shopping. It provides an incentive for a purchaser to buy because it offers to let the purchaser have, for free, goods or services for which he or she is shopping. This incentive is enhanced by letting the purchaser know in advance of the purchasing decision the probability he or she will obtain the object of purchase for free, as discussed at pages 1 and 2 of the present specification.

Wendkos discloses, for example, so-called "award algorithms" in detail at columns 10-12, but does not teach or suggest that the purchaser is ever informed what the probability is that he or she is entitled to such an award prior to the purchase. That is, the Wendkos reference fails to teach or suggest "said probability of purchase at no cost to said purchaser is communicated to the purchaser prior to selecting said at least one object for purchase."

Furthermore, the Kidron reference fails to bridge the substantial gap between the

applicant's invention and the Wendkos reference. In particular, Kidron discloses "the wager construction module provides the gift giver a selection of topics or categories grouping a series of bets, such as bets on particular events such as sports, weather reports, e.g., if it will rain in Los Angeles on a particular day, and so on. The wager construction module also provides selections of odds, bet amounts or stakes, and other types of information to the gift giver to create the gift wager" (see Kidron, Col. 5, lines 20-30).

Even if the two references could somehow be operably combined, the combination fails to disclose that the purchaser of the at least one object who views the probability of winning an award would ever win the cost for purchasing the award (e.g., gift wager), and the cost would be deducted from the payment. Rather, the Kidron reference, merely discloses, at most, another item that Wendkos could offer for free (i.e., namely, buying for a second party a bet that something will happen). The odds disclosed in the cited references have nothing to do with the odds of the purchaser getting the purchase at a reduced cost or for free. Rather, the odds disclosed in Kidron are associated with the actual gift (i.e., bet) for purchase for the second party, as opposed to odds associated with the purchaser buying the gift.

Moreover, the purchaser must first purchase (i.e., pay for) the object (e.g., the gift wager), and then after the purchase is made, if the purchased object is associated as being a winning wager, a second party (e.g., gift recipient) is eligible to collect the gift wager. Nowhere do the combined references teach or suggest that the purchaser of the at least one object will receive a reduction in price (via the "determining whether payment must be made" step of claim 3) when paying for the selected at least one object. By contrast, the purchaser has already paid full price for the selected object. Therefore, the combined references fail to embrace and solve the problems addressed by the Applicant's invention. Accordingly, the combined references fail to teach or suggest "said probability of purchase at no cost to said purchaser is communicated to the purchaser prior to selecting said at least one object for purchase," "determining whether payment must be made for said each of said at least one object of purchase," and "receiving payment for only those objects of purchase from said at least one object of purchase for which payment was determined to be required," since the combination of Wendkos and Kidron fails to teach or suggest all of the features and advantages of the applicant's invention as a whole.

As such, the Applicant submits that independent claim 3 is not obvious and fully satisfies the requirements under 35 U.S.C. § 103 and is therefore patentable. Furthermore, claims 4-5 and 8 recite features similar to those recited in independent claim 3. As such, and for at least the same reasons discussed above, the Applicant submits that these independent claims also fully satisfy the requirements under 35 U.S.C. § 103 and are patentable thereunder. Therefore, Applicant respectfully requests that the rejections be withdrawn.

CONCLUSION

The applicant believes that this Amendment responds to all of the points raised in the Office Action. Thus, the Applicant submits that claims 3-5 and 8 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, we request that the Examiner telephone the undersigned at (212) 885-9150 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Any fees associated with this Amendment may be charged or credited as the case may be to Deposit Account No. 01-0035.

All correspondence should continue to be directed to the address below.

Respectfully submitted,
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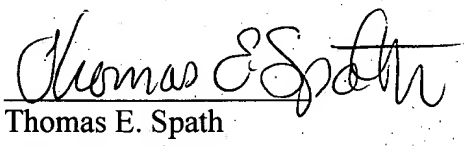
By: 
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